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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,996	06/20/2001	Hideto Kihara	1405.1044	2412
21171	7590	08/25/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			WON, MICHAEL YOUNG	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,996

Applicant(s)

KIHARA ET AL.

Examiner

Michael Y Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 have been examined and are pending with this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2, and 16 recites the limitation "said any network" in page 46, line 7, page 46, line 25, and page 52, line 20, respectively, of the specification. There is insufficient antecedent basis for this limitation in the claim. The preamble of claims 1, 2, and 16 recite "same network". There is no reference to any or plural networks.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 8-10, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Mattaway et al. (US 6,226,678 B1).

INDEPENDENT:

As per claims 1, 2, and 16, Mattaway teaches of a communication assistance method, device, and a computer-readable recording medium on which is recorded a communication assistance program, used in a communication device (see abstract: "directory server apparatus" and Fig.1, #26) capable of simultaneously carrying out two-way communication (see abstract: "point-to-point communications") among a plurality of users (see Fig.1, #12 and #22) sharing the same network (see col.12, lines 54-60), said method, device, and program comprising and including the steps of: A: correlating conditions relating to a transmission object (see col.15, lines 6-10) to said any network with the processings for said transmission object (see col.11, lines 52-60 and col.12, lines 3-11) and then stored in the first storage means (see col.7, lines 3-6); B: acquiring from said communication device information relating to said network in accordance with said conditions and said processings (see col.11, lines 60-64 and col.12, lines 11-16); C: prior to transmission of said transmission object to said network, determining based on said acquired network information whether said transmission

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object meets at least one of said conditions (inherent: see col.12, lines 36-41: since it is determined that the receiving device is "logged-in", the condition is met); D: conducting at least one of said processings on said transmission object based on said determination results (see col.18, lines 15-24), and sending said processed transmission object via said communication device to said network (see col.18, lines 30-36).

DEPENDENT:

As per claim 3, Mattaway teaches of further comprising second storage means (see Fig.15) storing user-dependent user information which corresponds to said conditions and processings, and registration means accepting input of said user information from a user, and storing the same in said second storage means (see col.6, lines 55-65).

As per claim 4, Mattaway teaches of further comprising second storage means (see Fig.15) storing user-dependent user information which corresponds to said conditions and processings, and registration means setting said user information based on said network information, and storing the same in said second storage means (see col.26, lines 43-55).

As per claim 5, Mattaway further teaches wherein network information that said acquisition means acquires from said communication device includes at least information specifying the network to which said transmission object is to be sent (see claim 2 rejection above) and transmission content (see col.22, line 50).

As per claim 6, Mattaway further teaches wherein network information that said acquisition means acquires from said communication device includes at least information specifying the network to which said transmission object is to be sent and transmission content, and, when said transmission object meets said condition (see claim 5 rejection above), said execution means notifies a user of said met condition and transmission content (see claim 2 rejection above), and depending on the response from the user to said notice, either transmits said transmission or cancels such transmission (inherent: see col.11, lines 56-64).

As per claim 8, Mattaway teaches of further comprising second storage means storing attributes of a network with which said communication device is communicating, wherein: said first storage means stores, as a condition, that the network to which said transmission object is to be sent has an attribute (see col.26, line 50 to col.27, line 57); and said determination means determines whether said condition is met based on attributes of the network to which the transmission object is to be sent, said attributes being stored in said second storage means (see claim 2 rejection above).

As per claim 9, Mattaway teaches of further comprising second storage means correlating the time of the latest message included in said transmission object within said network with said network and storing this correlated information (see col.12, lines 3-4); wherein: said first storage means stores as a condition, that a length of time has elapsed since the latest message was sent into the network to which said transmission object is to be sent (inherent see col.7, lines 3-6); and said determination means

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determines whether said transmission object meets said condition based on the time of the latest message in said network to which said transmission object is to be sent (see claim 2 rejection above).

As per claim 10, Mattaway further teaches wherein, stored as a condition in said first storage means is, that when a communications address is included in said transmission content, said network to which said transmission object is to be sent and said communications address belong to different computer networks (see col.4, lines 38-49), and said determination means determines whether said transmission object meets said condition based on the domain name of said communication device and the domain name of the information terminal providing said network to which said transmission object is to be sent (see claim 2 rejection above).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Mattaway et al. (US 6,226,678 B1).

As per claim 7, although Mattaway teaches of further comprising second storage means (see Fig.15), and a first storage means stores as a condition that in a network to which said transmission object is to be sent (see col.4, lines 48-49: "Internet Protocol (IP) addresses of logged-in units"), and said determination means determines, based on whether or not said transmission object meets said condition (see claim 2 rejection above), he does not explicitly teach that second storage stores users classified into classifications, wherein: said first storage means stores as a condition, the number of users belonging to a classification is within a range.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The comparing and determining if the conditions are met would be performed regardless of the conditions. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of within the system of Mattaway by implementing storing number of users belonging to a classification is within a range in said first storage and users classified into classification in said second storage within the communication assistance device because such conditions do not functionally relate to the steps, because the conditions are subjective and does not patentably distinguish the invention, and because Mattaway teaches that the "exact

arrangement of the feature bits... as well as the functions to which the individual bits relate, is a choice of the system designer" (see col.27, lines 53-57).

As per claim 11, Mattaway does not explicitly teach of comprising second storage means storing a correlation table containing degree of relevance between prescribed words, wherein: stored as a condition in said first storage means is, that the content of transmission object does not match the atmosphere of said network to which said transmission object is to be sent, and said determination means seeks degree of relevance between earlier communication content and content of said transmission object based on said correlation table, and determines whether said transmission object meets said condition by comparing said sought degree of correlation and a reference value (see claim 7 rejection above).

As per claims 12, Mattaway does not explicitly teach wherein stored as a condition in said first storage means is, that the usage rate of a language in previous communications is within a certain range, and said determination means determines the usage rate of said language based on identifiers marking the beginning and end of said language (see claim 7 rejection above).

As per claim 13, Mattaway does not explicitly teach wherein stored as a condition in said first storage means is, that said transmission object contains a word that another user has made a keyword in said network to which said transmission object is to be sent, and said determination means creates beforehand a list of said keywords based on said acquired network information, and based on said created keyword list,

determines whether or not said keyword is included in said transmission object (see claim 7 rejection above).

As per claim 14, Mattaway does not explicitly teach wherein stored as a condition in said first storage means is, that said transmission object is not in a format, and said determination means determines whether said transmission object is written in said format or not based on the transmission object acquired from said acquisition means (see claim 7 rejection above).

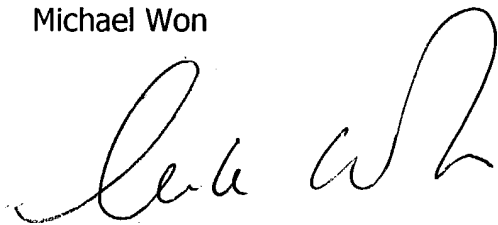
As per claim 15, Mattaway does not explicitly teach wherein stored as a condition in said first storage means is, that any portion of a communication in previously transmitted object has been selected, and when said transmission object meets said condition, said execution means adds information indicating that said transmission object is a response to said selected message to said transmission object (see claim 7 rejection above).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won

A handwritten signature in black ink, appearing to read 'Michael Won'.

August 19, 2004



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER